

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	§	
Sunny K. Yee et al.	§	Group Art Unit: 2176
	§	
Serial No.: 10/677,002	§	Examiner: Hillery, Nathan
Filed: October 1, 2003	§	
	§	
For: Method and Apparatus for	§	Atty. Docket: 200207281-1/SWA/TOM
Supporting Page Localization	§	NUHP:0119
Management in a Web Presentation	§	
Architecture	§	

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September 7, 2007	/Tait R. Swanson/
Date	Tait R. Swanson

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In accordance with the Official Gazette Notice of July 12, 2005, the Applicants respectfully submit this Pre-Appeal Brief Request for Review. This Request is being filed concurrently with a Notice of Appeal.

In the Final Office Action, mailed June 7, 2007, the Examiner rejected claims 1-23 under Section 101 for allegedly reciting non-statutory subject matter. The Examiner also rejected claims 1-27 under Section 102 as allegedly anticipated by Parasnis et al., U.S. Publication No. 2001/0044809 (hereafter "Parasnis"). The Applicants respectfully request withdrawal of these rejections in view of clear legal and factual errors as discussed in the Amendment and Response filed on March 13, 2007 (hereinafter "Response"), and as discussed further below.

Rejections under 35 U.S.C § 101

Applicants respectfully assert that the Examiner's rejection under Section 101 is improper. As previously argued, each independent claim 1, 8, 15, and 18 recites either a method or apparatus for receiving and responding to a request from a user and selecting a localized version of the requested page. *See* Response, pages 6-8. Applicants assert that processing a client request and retrieving a localized page is a useful, concrete, and tangible result. As stated in the specification, the localized page may be displayed in a client browser and may be an HTML or XML formatted page displaying static or dynamic data *See* Specification, pp. 10-11, ¶ [0021].

Further, Applicants refer the Examiner to the attached PTO memo dated April 12, 2007 entitled "Clarification of Interim Guidelines For Examination of Patent Applications for Subject Matter Eligibility." Under the clarification provided by the memo, Applicants believe that independent claims 1, 8, 15, and 18 clearly provide a result that has "a real world practical application/use" according to the test set forth in the memo. Thus, Applicants respectfully request withdrawal of the rejection of claims 1-23 under Section 101

Rejections under 35 U.S.C § 102

The Examiner also rejected claims 1-27 under Section 102 as allegedly anticipated by Parasnis. However, as discussed in detail in the previous Response, the Applicants respectfully stress that the Parasnis does not disclose each and every feature of independent claims 1, 8, 15, and 18. *See* Response, pages 9-11. As stated in the previous Response, independent claims 1, 8, 15 and 18 each recite selection or identification of a "localized page," a "a locale-version of a requested page from a plurality of localized pages," a "localized version of a requested page," or a "localized one of a plurality of localized pages" respectively. *See* Response, page 10 (Emphasis added). In contrast, as stated in Parasnis and by the Examiner, Parasnis discloses producing display pages containing "localized objects that convey content in the language selected by the user." Final Office Action, page 3 (Emphasis added). Further, as stated in Parasnis, the goal of the system disclosed in Parasnis is "that a single set of markup language

documents (or a single document, if applicable) can be used to support a plurality of different languages.” Parasnis, ¶ [0008] (Emphasis added).

Thus, Parasnis cannot anticipate independent claims 1, 8, 15, and 18 because Parasnis discloses an entirely different system of localization. Parasnis discloses a single set of pages in which objects in those pages are replaced with localized objects. Parasnis, ¶ [0008]. Independent claims 1, 8, 15 and 18 recite a localized page for each locale, thus using a different page or set of pages for each locale. This is far different than replacing a set of objects on a page with localized objects as disclosed in Parasnis, as only one page or set of pages is used for all locales. Accordingly, Parasnis does not disclose each and every feature recited in the present independent claims. As such, Parasnis cannot anticipate independent claims 1, 8, 15, and 18 and the claims that depend therefrom.

Respectfully submitted,

Date: September 7, 2007

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MEMORANDUM

DATE: April 12, 2007

TO: Technology Center Directors

FROM: John J. Love *JJL*
Deputy Commissioner
For Patent Examination Policy

SUBJECT: **Clarification of Interim Guidelines For Examination of Patent Applications
for Subject Matter Eligibility**

Certain inconsistencies have come to my attention in the application of the Interim Guidelines For Examination of Patent Applications for Subject Matter Eligibility, which are set forth in section 2106 of the Manual of Patent Examining Procedure (8th Ed. Rev. 5, Aug. 2006) (MPEP). The situation arises in the context of whether or not a claim is for a practical application of an abstract idea, law of nature, or natural phenomenon. As stated in the Interim Guidelines, a claim is for a practical application of an abstract idea, law of nature, or natural phenomenon when the claimed invention "transforms" an article or physical object to a different state or thing, or when the claimed invention produces a useful, concrete and tangible result. See MPEP 2106, subsection IV.C.2.

Focus on Result

A practical application in this context can be the result itself, and does not require that steps or additional limitations be added to the claim. As stated in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998):

Today, we hold that the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces "a useful, concrete and tangible result"-- a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.

It is the result that should be the focus. If the result has a real world practical application/use, then the test has been satisfied. The claim need not include the uses to which the result is ultimately put, just the result itself. Another example would be an improved method for measuring blood sugar levels in human beings. In this example, the end result is the blood sugar level which is a practical application for diagnostic purposes. Accordingly, reciting the improved method, and the result it achieves---the measurement of the blood sugar level---is all that is necessary for patent-eligibility. The diagnostic steps that occur after the determination of the blood sugar level need not necessarily be present in the claims in order for the claims to be statutory.

Use of Specific Terminology

Another area of inconsistency surrounds the use of the terms such as “determining,” “calculating,” and similar expressions. Some object to these as not creating a tangible result. Such terms may in fact be sufficient to establish a tangible result. *See, e.g., State Street*, 149 F.3d at 1375, 47 USPQ2d at 1602 (holding the calculation of a number having a real world value and to be a “useful, concrete, and tangible result”) and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999) (holding a method claim including the generation of a message record for an interexchange call to be statutory). The specification should be referred to for a meaning of the terms. *See In re Musgrave*, 431 F.2d 882, 893, 167 USPQ 280, 289 (CCPA 1970) (“[w]e cannot agree with the board that these claims (all the steps of which can be carried out by the disclosed apparatus) are directed to non-statutory processes merely because some or all the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing the processes to think. . . .”).